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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,033	06/25/2001	Howard H. Liebermann	30-4698US/11872-026001	9448

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11/22/2002

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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 11/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant(s) ORLOFF ET AL		
	<table border="1"> <tr> <td>Applicant N 09/891,033</td> <td>Examiner George P Wyszomierski</td> <td>Art Unit 1742</td> </tr> </table>	Applicant N 09/891,033	Examiner George P Wyszomierski
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election with traverse of Group I in Paper No. 5 is acknowledged.

The traversal is on the ground(s) that the elected claims as amended are written in product-by-process format and imply certain properties which would only be achievable by the non-elected process. This is not found persuasive because any allegedly unique properties of the claimed products are defined in general terms only, e.g. "superior" magnetic properties or cutting properties and no nexus has been established between any particular properties of the elected products and any defined method, such as the method of the non-elected claims.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Narasimhan (U.S. Patent 4,332,848).

Narasimhan discloses glassy metal strips having a composition within the limitations of instant claim 4 and which contain a repeating geometrical pattern of structurally defined protuberances and/or indentations. With respect to claims 6-9, the examiner's position is that the suitability of a material for abrasive or cutting purposes is directly related to its composition,

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shape, and relative hardness to the material being abraded or cut. Because all of these parameters are the same in the prior art or the claimed invention, the examiner's position is that the claimed limitations are inherent in the Narasimhan material. Thus, the Narasimhan products are held to fully meet the limitations of the instant claims.

4. Claims 1, 2, 4-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (U.S. Patent 5,622,768).

Watanabe discloses wound or laminated magnetic cores made from amorphous alloy strips having a composition within the limitations of instant claims 4 and 5. The limitations of instant claims 6-9 are inherent in the Watanabe materials for reasons as set forth in item no. 8 supra. The Watanabe materials have a defined surface roughness value (see Watanabe Table 2) and are thus held by the examiner to possess "articulated topographical definition". Thus, the Watanabe products are held to fully meet the limitations of the instant claims.

5. Claims 1, 2, and 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al. (U.S. Patent 4,865,664).

Sato discloses amorphous alloy strips having a composition within the limitations of instant claims 4 and 5. The limitations of instant claims 6-9 are inherent in the Sato materials for reasons as set forth in item no. 8 supra. The Sato materials have a defined surface roughness value (see the Tables of Sato) and are thus held by the examiner to possess "articulated topographical definition". Thus, the Sato products are held to fully meet the limitations of the instant claims.

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6. Claims 1, 2, 6-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 62-250153.

The JP '153 reference discloses laminated amorphous metal sheets with a defined surface roughness; this is taken to be the full patentable equivalent of the claimed "articulated topographical definition". The limitations of instant claims 6-9 are held to be inherent in the JP '153 materials for reasons as set forth in item no. 8 supra. Thus, the products disclosed in JP '153 are held to fully meet the limitations of the instant claims.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan in view of Watanabe et al. or Sato et al.

The Narasimhan products do not appear to contain element "Z" as defined in instant claim 5. The Watanabe and Sato et al. patents indicate that it is conventional in the art to include element "Z" in amorphous alloy strip compositions, in the amounts as defined in the instant claim. Consequently, the Watanabe or Sato disclosures would have motivated one of ordinary skill in the art to produce the Narasimhan products containing an amount of element "Z" as defined in the present claims.

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9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan in view of either Watanabe et al. or Bruckner (U.S. Patent 4,853,292).

The Narasimhan patent does not discuss a plurality of stacked materials or transformer cores, as required by the instant claims. Both Watanabe and Bruckner indicate it to be conventional in the art to form laminated magnetic cores by using a plurality of layers of amorphous metal alloys. These disclosures would have motivated one of ordinary skill in the art to form the materials disclosed by Narasimhan into the configurations as set forth by Watanabe or Bruckner.

10. In a response filed September 23, 2002, Applicant has amended certain claims to overcome previous rejections under 35 USC 112, and presents arguments that claim 1 as amended as well as claims dependent therefrom are allowable over the prior art of record. The response has been fully considered, with the following effect.

a) With regard to the rejections under 35 USC 112, the examiner agrees that Applicant has overcome these rejections. However, the examiner cautions that Applicant's claims are not limited to certain features asserted by Applicant on page 6 of the response. For example, the instant claims do not limit the articulated topographical definition to a "non periodic geometrical articulation", nor do the instant claims define the thickness of the topographical definitions.

b) With regard to the prior art, Applicant alleges that the claimed products possess either certain properties or certain geometrical features not present in the Narasimhan products. However, Applicant has pointed to no specific property value which is different in the claimed invention as opposed to the Narasimhan material. Also, any allegedly distinct geometrical features (e.g. non periodic, etc.) are not claimed. Applicant further alleges that the surface roughness disclosed by Watanabe, Sato or JP '153 defines a surface feature on a microscopic

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scale as opposed to a macroscopic scale. However, this does not serve to define the claimed invention over the prior art because the instant claims do not place any limit upon the size of the claimed articulated topographical definition.

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
November 20, 2002